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EXAMINER

CAPUTO, LISA M

ART UNIT PAPER NUMBER

2876

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,147

Applicant(s)

FRANCOIS, MAUREL

Examiner

Lisa M Caputo

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-17 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed 24 March 2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 and 7-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Goman et al. (U.S. Patent No. 6,196,459, from hereinafter "Goman").

Goman teaches a system for smart card personalization in a multistation environment having all of the elements and means as recited in claims 1-3 and 7-17 of the instant application.

Goman discloses that FIG. 1 illustrates components of a smart card issuing process that incorporates one embodiment of the smart card personalization server of the present invention. The smart card personalization server 100 receives card objects from a card issuer management system 150. A smart card personalization controller 120 receives, from the card issuer management system 150, a card object identifier for each one of the card objects passed to the smart card personalization server 100. The smart card personalization controller 120 routes each one of the card object identifiers

to one of a plurality of personalization stations 130. Each personalization station 130 uses the card object identifier to request data and services from the smart card personalization server 100 in order to personalize a smart card 160. The card issuer management system 150 manages the cardholder data and determines the type of card to issue, the card applications to embed in the card, and what personalization equipment to use to issue the card for a particular cardholder (see Figure 1, col 3 line 52 to col 4 line 3). The server 100 controls card printers, embossing devices, and integrated or add-on smart card interface devices collectively represented in FIG. 1 as a plurality of personalization stations 130. Personalization stations 130 also represent such devices as large volume card printer/embossers, small volume card printer/embossers, automatic teller machines (ATMs), point of sale terminals, unattended kiosks, personal computers, network computers, and on-line telecommunication devices. The physical connection between the devices and the smart card personalization server 100 varies according to the manufacturer and model of the device. Common industry standard connections include serial RS232, SCSI (Small Computer System Interface), Ethernet, and serial TTL (Transistor-Transistor Logic) as recited in claim 3 of the instant application. In addition, some devices require a proprietary bus connection (see Figures 1-3, col 4, lines 13-34).

Hence Goman teaches a smart card customizing station comprising a personalization station 130 (customizing station that sends customizing data requests), a server 100 (customizing data server that delivers customizing data), and a card issuer management system 150 working together with the controller 120 (management

interface connected to the customizing machine and to the data server by a bi-directional link, with the interface receiving requests and transmitting them to the servers and receiving response and then transmitting it to the customizing station) in order to customize user cards as recited in claims 1-2 and 7-8. Regarding claim 3, Goman teaches that the personalization software 305 operates on a computer system which includes one or more high speed processors, data communications capability compatible with the target personalization stations, access to external resources such as security or file servers and a multitasking operating system (see Figure 3, col 6 line 63 to col 7 line 1).

Regarding claims 9-17, Goman teaches that FIG. 3 is a block diagram showing one embodiment of the smart card personalization server 100 of FIG. 2. The system of the present invention utilizes the personalization server 100 to control smart card personalization in an environment having a plurality of personalization stations 130 coupled to the personalization server 100. The personalization server 100 provides an interface to card personalization stations 130 and to external computing or data resources 204, 206 as shown in FIG. 2 (see Figures 2-3, col 5, lines 48-56). Further, the server 100 controls card printers, embossing devices, and integrated or add-on smart card interface devices collectively represented in FIG. 1 as a plurality of personalization stations 130. Personalization stations 130 also represent such devices as large volume card printer/embossers, small volume card printer/embossers, automatic teller machines (ATMs), point of sale terminals, unattended kiosks, personal computers, network computers, and on-line telecommunication devices. The physical

connection between the devices and the smart card personalization server 100 varies according to the manufacturer and model of the device. Common industry standard connections include serial RS232, SCSI (Small Computer System Interface), Ethernet, and serial TTL (Transistor-Transistor Logic) (as recited in claims 12-13 and 17 of the instant application). In addition, some devices require a proprietary bus connection (see Figures 1-3, col 4, lines 13-27). Regarding claim 14, Goman teaches that the personalization software 305 operates on a computer system which includes one or more high speed processors, data communications capability compatible with the target personalization stations, access to external resources such as security or file servers and a multitasking operating system (see Figure 3, col 6 line 63 to col 7 line 1). Hence, Goman teaches a plurality of customizing machines and devices as recited in claims 9-11 and 15-16.

Allowable Subject Matter

3. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The best prior art of record fails to teach the specific communication links and their connections as well as the switching circuits and their connections.

Response to Arguments

4. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2876

Examiner appreciates applicant's comments and has provided new art in the form of Goman. See 35 U.S.C. 102 rejections above.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(703) 308-8505**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**lisa.caputo@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



LMC

May 30, 2003



THIEN M. LE
PRIMARY EXAMINER